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NO. 3682 P. 1

OCT 23 2006

Docket No.: 13156-00057-US
(PATENT)

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By: [Signature]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Markus Siegert et al.

Application No.: 10/583,698

Confirmation No.: N/A

Filed: June 20, 2006

Art Unit: N/A

For: METHOD FOR SEPARATING TRIOXANE
FROM A
TRIOXANE/FORMALDEHYDE/WATER
MIXTURE BY MEANS OF PRESSURE
CHANGE RECTIFICATION

Examiner: Not Yet Assigned

LETTER

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

For the sake of completeness attached is a copy of the International Preliminary Report on Patentability regarding the PCT counterpart for the above application.

Dated:

Respectfully submitted,

By [Signature]
Harold Pezzner

Registration No.: 22,112
CONNOLLY BOVE LODGE & HUTZ LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, Delaware 19899

OCT. 23. 2006 11:50AM

NO. 3682 P. 2

(302) 658-9141
(302) 658-5614 (Fax)
Attorney for Applicant

494545

PATENT COOPERATION TREATY

From the INTERNATIONAL BUREAU

PCT

NOTIFICATION OF TRANSMITTAL
OF COPIES OF TRANSLATION
OF THE INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY
(CHAPTER I OR CHAPTER II
OF THE PATENT COOPERATION TREATY)
(PCT Rules 44bis.3(c) and 72.2)

To:

ISENBRUCK, Günter
Isenbruck, Bösl, Hörschler, Wichmann, Huhn
Theodor-Heuss-Anlage 12
68165 Mannheim
ALLEMAGNE

B1	
B2	
B3	
Sekr.	CC
EDV	
Abg.	

Date of mailing (day/month/year) 08 September 2006 (08.09.2006)	13. Sep. 2006	IMPORTANT NOTIFICATION
Applicant's or agent's file reference B03/0625PC	Frist:	
International application No. PCT/EP2004/014535	Vorfrist: WV:	International filing date (day/month/year) 21 December 2004 (21.12.2004)
Applicant BASF AKTIENGESELLSCHAFT et al		

1. Transmittal of the translation to the applicant.



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter I).



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter II).

2. Transmittal of the copy of the translation to the designated or elected Offices.

The International Bureau notifies the applicant that copies of that translation have been transmitted to the following designated or elected Offices requiring such translation:

None

The following designated or elected Offices, having waived the requirement for such a transmittal at this time, will receive copies of that translation from the International Bureau only upon their request:

AE, AG, AL, AM, AP, AT, AU, AZ, BA, BB, BG, BR, BW, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EA, EC, EE, EG, EP, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NA, NI, NO, NZ, OA, OM, PG, PH, PL, PT, RO, RU, SC, SD, SE, SG, SK, SL, SM, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, YU, ZA, ZM, ZW

3. Reminder regarding translation into (one of) the official language(s) of the elected Office(s).

The applicant is reminded that, where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability (Chapter II).

It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned within the applicable time limit (Rule 74.1). See Volume II of the PCT Applicant's Guide for further details.

The International Bureau of WIPO
34, chemin des Colombes
1211 Geneva 20, Switzerland

Facsimile No. +41 22 338 82 70

Authorized officer

Agnes Wittmann-Regis

Facsimile No. +41 22 338 82 70

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference B03/0625PC	FOR FURTHER ACTION		See item 4 below
International application No. PCT/EP2004/014535	International filing date (<i>day/month/year</i>) 21 December 2004 (21.12.2004)	Priority date (<i>day/month/year</i>) 23 December 2003 (23.12.2003)	
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237			
Applicant BASF AKTIENGESELLSCHAFT			

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 *bis* 1(a).

2. This REPORT consists of a total of 6 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- | | |
|--|---|
| <input checked="" type="checkbox"/> Box No. I | Basis of the report |
| <input type="checkbox"/> Box No. II | Priority |
| <input type="checkbox"/> Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> Box No. VI | Certain documents cited |
| <input type="checkbox"/> Box No. VII | Certain defects in the international application |
| <input checked="" type="checkbox"/> Box No. VIII | Certain observations on the international application |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis.2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland Facsimile No. +41 22 338 82 70	Date of issuance of this report 29 August 2006 (29.08.2006)
	Authorized officer Agnes Wittmann-Regis e-mail: pr06@wipo.int

Form PCT/IB/373 (January 2004)

PATENT COOPERATION TREATY

TRANSLATION

From the
INTERNATIONAL SEARCHING AUTHORITY

To:

PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

Date of mailing
(day/month/year)

See form PCT/ISA/210

Applicant's or agent's file reference

B03/0625PC

FOR FURTHER ACTION

See paragraph 2 below

International application No.

PCT/EP2004/014535

International filing date (day/month/year)

21.12.2004

Priority date (day/month/year)

23.12.2003

International Patent Classification (IPC) or both national classification and IPC

C07D323/06

Applicant

BASF AKTIENGESELLSCHAFT

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability: citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/EP

Authorized officer

Facsimile No.

Telephone No.

Form PCT/ISA/237 (cover sheet) (January 2004)

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

PCT/EP2004/014535

Box No. I

Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ This opinion has been established on the basis of a translation from the original language into the following language
 _____, which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).
2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material

☐ a sequence listing
☐ table(s) related to the sequence listing
 - b. format of material

☐ in written format
☐ in computer readable form
 - c. time of filing/furnishing

☐ contained in the international application as filed.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2004/014535

Box No. V	Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability: citations and explanations supporting such statement		
1. Statement			
Novelty (N)	Claims	1-15	YES
	Claims		NO
Inventive step (IS)	Claims	1-15	YES
	Claims		NO
Industrial applicability (IA)	Claims	1-15	YES
	Claims		NO
2. Citations and explanations:			
See supplemental sheet			

Form PCT/ISA/237 (Box No. V) (January 2004).

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2004/014535

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

See supplemental sheet

Form PCT/ISA/237 (Box VIII) (January 2004)

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2004/014535

Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

Continuation of:

Boxes V and VIII

1. Owing to the use of a pressure-swing rectification, the claimed process for removing trioxane from a trioxane/formaldehyde/water mixture is novel over the prior art represented by the documents cited in the international search report.
2. In view of the fact that the claimed process surprisingly allows trioxane to be removed in high yield and purity without the prior art extraction and/or pervaporation steps, which was not obvious to a person skilled in the art in the light of this prior art, provision thereof is regarded as involving an inventive step pursuant to PCT Article 33(3).
3. Claim 15 in its current form represents an inadmissible product-by-process claim which is envisaged only for cases where the product cannot be adequately characterized by its composition, its structure or other testable parameters.